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26096 7590 07/16/2003

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EXAMINER

FLANDRO, RYAN M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3679

DATE MAILED: 07/16/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/068,473

Applicant(s)

LE GALLO ET AL.

Examiner

Ryan M Flandro

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16, 19-21, 24, 26, and 28 is/are rejected.
- 7) ☒ Claim(s) 17, 18, 22, 23, 25 and 27 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Specification***

1. In light of Applicant's Amendment submitted 21 April 2003, the objection to the specification set forth in the previous Office action (paper no. 7) is hereby withdrawn.

### ***Claim Objections***

2. In light of Applicant's Amendment submitted 21 April 2003, the objections to claims 7, 16, and 20 are hereby withdrawn.

### ***Claim Rejections - 35 USC § 112***

3. In light of Applicant's Amendment submitted 21 April 2003, the rejections set forth in the previous Office action (paper no. 7) under 35 USC §112, second paragraph, are hereby withdrawn.

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Newly added claims 21, 24 (which depends from claim 21), and 28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the recitation of a

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“further third component distinct from the assembly,” the step of “placing on the assembly the further third component,” and the recitation that “the first component is a window frame” are nowhere included in the disclosure as filed.

***Claim Rejections - 35 USC § 103***

6. Claims 1-16 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ross (US 1,986,981) in view of Tanaka et al (US 6,053,653) (Tanaka).

a. Claim 1. Ross (figure 4) clearly discloses an assembly including a first **3**, second **A** and third **B, 2** components and a first **1ax, 4** and second **1b** fixing members, the first **3**, second **A**, and third **B, 2** components having respective first, second and third holes, the first fixing member **1ax, 4** cooperating with the second hole and engaging the first hole to secure the first component **3** to the second component **A**, at least one of the fixing members [**1ax, 4**], **1b** cooperating with the third hole with the first fixing member **1ax, 4** engaging the second fixing member **1b** to secure the third component **B, 2** to the first component **3**, in which the first component **3** is situated between the second **A** and third **B, 2** components (see figure 4; column 1 lines 1-2, 17-22, 28-31; column 2 lines 43-44). Ross fails to disclose the first hole being a threaded hole, in which a first threaded portion of the first fixing member engages the first hole. Tanaka, however, teaches a first hole **52** being a threaded hole, in which a first threaded portion **65** of the first fixing member engages the first hole **52** (figure 6; column 8 lines 29-51) in order to secure the first component **2** to the second component **1**. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made modify the first hole

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and the first fixing member of Ross by providing that the first hole be a threaded hole and the first fixing member have a first threaded portion which engages the first hole in order to secure the first component to the second component as taught by Tanaka.

b. Claim 2. Ross further shows a first feature **a** on the first component **3** which engages a first feature **a** on the second component **A** to align the first component **3** relative to the second component **A** (see figure 6; column 1 lines 23-35).

c. Claim 3. Ross further shows the second component **A** having a first surface (opposite side of **A** from **a**) for engagement with the first fixing member **1ax, 4** to align the second component **A** relative to the first component **3** (see figure 6).

d. Claim 4. Ross shows a first feature (opposite side of **B** from **b**) on the third component **B, 2** engaging a second feature (opposite side of **B** from **b**) of the first component **3** to align the first component **3** relative to the third component **B, 2** (see figure 6; column 1 lines 23-35).

e. Claim 5. Ross discloses that the first feature of at least one of the components **3, A, B** is a recess (figure 6; column 1 line 31).

f. Claim 6. Ross discloses that the first feature of at least one of the components **3, A, B** is a projection (figure 6; column 1 line 30).

g. Claim 7. Ross discloses that the first feature (opposite side of **B** from **b**) of the third component **B, 2** is a recess (figure 6; column 1 line 31).

h. Claim 8. Ross further discloses that second feature (opposite side of **B** from **b**) of the first component **3** is a projection (figure 6; column 1 line 30).

i. Claim 9. Ross further shows that at least one of the first feature **a** of the first component **3** and the first feature **a** of the second component **A** is contiguous with at least one of the holes (see figure 6).

j. Claim 10. Ross further shows at least one of the first feature (opposite side of **B** from **b**) of the third component **B, 2** and the second feature (opposite side of **B** from **b**) of the first component **3** is contiguous with at least one of the holes (see figure 6).

k. Claim 11. Ross further shows a first feature (opposite side of **B** from **b**) on the third component **B, 2** engages a second feature (opposite side of **B** from **b**) of the first component **3** to align the first component **3** relative to the third component **B, 2** and the first **a** and second (opposite side of **B** from **b**) features of the first component **3** are on opposite sides of the first component **3** and are aligned (see figure 6; column 1 lines 29-31).

l. Claim 12. Ross discloses the first feature **a** of the first component **3** is a recess and the second feature (opposite side of **B** from **b**) of the first component **3** is a projection (figure 6; column 1 lines 29-31).

m. Claim 13. Ross discloses that the first component **3** is made from metal (column 1 lines 1-2). As to the latter part of the claim, the method of forming the first hole is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight.

n. Claim 14. Ross further shows the third component **B, 2** having a first surface (wall of hole through **2**) for engagement with the first **1ax, 4** fixing member to align the third component **B, 2** relative to at least one of the first **3** and second **A** components.

- o. Claim 15. Ross shows the first component **3** sealed relative to the second component **A** and the first component **3** sealed relative to the third component **B** (see figure 6).
- p. Claim 16. Although the combination of Ross and Tanaka does not explicitly include forces acting on the first fixing member preventing rotation of the first fixing member relative to the first component during securing and releasing of the third component by the second fixing [member], this would be inherent to the combination because upon tightening of the second fixing [member] **1b** to the first fixing member **1ax**, **4** there would be a resulting friction force between the first fixing member **1ax**, **4** and the first component **3** thus preventing relative rotation between the two features. Note that where there is reason to believe that a functional limitation asserted to be critical to establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, Applicant may be required to prove that the subject matter shown in the prior art does not possess the characteristic relied upon. In re Spada, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990); In re King, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986); In re Hallman, 655 F.2d 212, 215, 210 USPQ 609, 611 (CCPA 1981); In re Fitzgerald, 619 F.2d 67, 70, 205 USPQ 594, 596-97 (CCPA 1980); In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977); In re Ludtke, 441 F.2d 660, 664, 169 USPQ 563, 566 (CCPA 1971); In re Swinehart, 439 F.2d 210, 213, 169 USPQ 226, 229 (CCPA 1971).
- q. Claim 19. Ross (figure 4) clearly discloses an assembly including a first **3**, second **A** and third **B**, **2** components and a first **1ax**, **4** and second **1b** fixing members, the

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first **3**, second **A**, and third **B**, **2** components having respective first, second and third holes (see figure 4; column 1 lines 1-2, 17-22, 28-31; column 2 lines 43-44).

- i. Ross fails to disclose the first hole being a threaded hole, in which a first threaded portion of the first fixing member engages the first hole.
- ii. Tanaka, however, teaches a first hole **52** being a threaded hole, in which a first threaded portion **65** of the first fixing member engages the first hole **52** (figure 6; column 8 lines 29-51) in order to secure the first component **2** to the second component **1**. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made modify the first hole and the first fixing member of Ross by providing that the first hole be a threaded hole and the first fixing member have a first threaded portion which engages the first hole in order to secure the first component to the second component as taught by Tanaka.
- iii. Further, as to the steps of assembling the first and second components and first fixing member to form a subassembly such that the first fixing member extends through the second hole and a first threaded portion of the first fixing member engages the first hole to secure the first component to the second component; then assembling the third component to the subassembly, and then mounting the second fixing member on the first fixing member with the first fixing member engaging the second fixing member to secure the third component to the first component to form an assembly such that at least one of the fixing members extends through the third hole in which the first component is situated



between the second and third component, *the combination of Ross and Tanaka as set forth above, would include these steps*. Under the principles of inherency, if a prior art device, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art device. When the prior art device is the same as a device described in the specification, it can be assumed the device will inherently perform the same process. *In re King*, 802 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986). Therefore, these steps would be inherent to the combination of Ross and Tanaka as set forth above.

r. Claim 20. The combination of Ross and Tanaka as set forth above includes each limitation recited in claim 20 except for *explicit* disclosure of the steps of removing the second fixing member, removing the third component, replacing the third component, and replacing the second fixing member. Nevertheless, a process of replacing the third component **B, 2** of Ross would include removing the second fixing member **1b**, removing the third component **B, 2**, replacing the third component **B, 2**, and replacing the second fixing member **1b** (see figure 4). Note that under the principles of inherency, if a prior art device, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art device. When the prior art device is the same as a device described in the specification, it can be assumed the device will inherently perform the same process. *In re King*, 802 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986). Therefore, these steps would be inherent to the combination of Ross and Tanaka as set forth above.

s. Claim 21. The combination of Ross and Tanaka includes each limitation recited in claim 21 except for *explicit* disclosure of the steps of providing a further third component distinct from the assembly, removing the second fixing member, removing the third component from the assembly, placing on the assembly the further third component, and replacing the second fixing member. Nevertheless, a process of replacing the third component **B, 2** of Ross with another third component distinct from the assembly would include removing the second fixing member **1b**, removing the third component **B, 2**, placing on the assembly the further third component **B, 2**, and replacing the second fixing member **1b** (see figure 4). Note that under the principles of inherency, if a prior art device, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art device. When the prior art device is the same as a device described in the specification, it can be assumed the device will inherently perform the same process. *In re King*, 802 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986). Therefore, these steps would be inherent to the combination of Ross and Tanaka as set forth above.

t. Claim 26, as best understood. The combination of Ross and Tanaka, as applied to claim 1 above, includes the first hole being pre-threaded. Because the disclosure offers no definition of the limitation “pre-threaded,” the Examiner has read the limitation broadly (e.g., the first hole may be threaded prior to assembly with the third component).

***Response to Arguments***

7. Applicant's arguments filed 21 April 2003 have been fully considered but they are not persuasive.

a. Applicant first argues that "in *Tanaka*, there is no first component situated between a second and third component." The limitation of a first component situated between a second and third component is disclosed by Ross and Tanaka is merely cited to teach a threaded first hole in a first component which, in conjunction with a first fixing member, serves to secure the first component to a second component. Thus, in response to this argument against the references individually, the Examiner notes that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

b. Second, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation is provided by Tanaka in providing a means by which first and second components may be secured together where a fixing member passes through the second member to engage the first member. (See paper no. 7, subsection 9(a)). Additionally, as to Applicant's argument

that “none of the components of Figure 4 of *Ross* are threaded to receive the fixing member,” the Examiner points out that this is the very reason *Tanaka* is cited as a teaching reference.

c. Third, Applicant argues that *Tanaka* “discloses a dual cutting thread arrangement for securing two components with a ‘blind hole’”. In response, the Examiner notes that the fact that *Tanaka* discloses additional structure not claimed by the Applicant is irrelevant. The combination of *Ross* and *Tanaka*, as set forth above, reads on the invention as claimed. Further, as to Applicant’s argument that “[n]othing in *Tanaka*, would suggest threading the *Ross* washer 3,” the Examiner points again to the motivation provided in subsection 6(a) above.

d. Fourth, Applicant argues that *Tanaka* teaches away from a combination with *Ross* because *Tanaka* states that “it is unnecessary to take the fastening strength into consideration.” Applicant further argues that “the present invention requires there to be a strong connection at this location to secure the components together.” In response, the Examiner notes that the feature upon which applicant relies (i.e., the requirement of a strong connection) is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In any event, the Examiner fails to see how this statement in *Tanaka* renders any combination with *Ross* invalid.

e. Fifth, Applicant argues that “*Tanaka* teaches that the asserted first hole has threads created from tapping by screw 63” and that “the holes of *Ross* are not sized for tapping

but are, instead, sized to receive without interference rivet 1.” In response, the Examiner notes that it is immaterial how *Tanaka* goes about forming the threads relied upon for the combination.

f. Sixth, Applicant argues that claim 15 requires the first component to be sealed relative to the second and third component, respectively. The Examiner maintains that the contact shown in the several embodiments of *Ross* between the first and second components, as well as between the first and third components, constitutes a seal within the common meaning of the term. As defined by Webster’s New World Dictionary, Second College Edition (1980), a seal can be defined as, *inter alia*, “a tight closure.” Thus, the components in *Ross* fall within this definition.

g. Seventh, Applicant argues that “nothing within *Ross* or *Tanaka* teaches that the first fixing member is secured against rotation relative to the first component ‘during securing and releasing of the third component by the second fixing member.’” In response, the Examiner notes that the reason *Tanaka* is cited in combination with *Ross* is to teach the threads formed on the first hole of the first component for securing first and second components together. Inherent in the resulting combination is the fact that any rotation between the first fixing member and the first component will be prevented due to frictional forces between the threads of the first hole and the threads of the first fixing member. In this view, the Examiner maintains that the combination is proper and meets the recited limitations of the claim.

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h. Eighth, in response to Applicant's arguments addressing the rejections of claims 17 and 18, the Examiner is persuaded, for the reasons given by Applicant, that the combination is not proper as to these limitations.

i. Lastly, as to Applicant's argument pertaining to the rejections of claims 19 and 20, the rejections presented above address any and all arguments. Any changes to the rejection of claim 19 were necessitated by amendment.

***Allowable Subject Matter***

8. Claims 17, 18, 22, 23, 25, and 27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The following is a statement of reasons for the indication of allowable subject matter: Claims 22, 23, and 27 are indicated as allowable because the prior art, including Ross and Tanaka, fails to disclose or teach the first component of such an assembly being a door panel or door module, the second component being a window regulator mechanism, and the third component being a window regulator drive system.

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents are cited to further show the state of the art with respect to Door Panel Assemblies:

U.S. Patent 5,778,599 to Saito

U.S. Patent 5,647,171 to Wirsing et al.

U.S. Patent 5,622,005 to Ochenski et al.

U.S. Patent 5,502,926 to Grace et al.

U.S. Patent 4,848,032 to Ballor et al.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan M Flandro whose telephone number is (703) 305-6952. The examiner can normally be reached on 8:30am - 5:30pm Mon-Fri.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne H Browne can be reached on (703) 308-1159. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Ryan M. Flandro  
July 14, 2003

  
**Lynne H. Browne**  
***Supervisory Patent Examiner***  
**Technology Center 3670**